

*REMARKS*

Claim 1 has been amended to specify that the second primer comprises a sequence complementary to either the sense or the antisense strand of the siRNA molecule along with a terminator sequence. Claim 1 has further been amended to delete the “loop” feature.

Claims 10-16 have been canceled.

Applicants submit that none of these amendments constitute new matter, and their entry is requested.

**Rejection under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-5 and 8-21 under 35 U.S.C. §103(a) as being unpatentable over Paddison et al. (published 15 April 2002) in view of Tuschl (published in May 2002), Yu et al. (published 30 April 2002), Livache (1998), and Jones (1990). The application claims the priority of 60/399,718, filed 8/1/2002 and 60/408,298, filed 9/6/2002. As noted in response to the previous Office Action, Applicants determined that the present invention was made prior to 15 April 2002 and thus prior to each of Paddison et al., Tuschl and Yu et al. Accordingly, Applicants filed a Rule 131 Declaration in which the inventors swear behind these references, thereby removing them as prior art.

In response to the filing of the Rule 131 Declaration, the Examiner contended that it was insufficient to establish a date prior of invention prior to the date of Paddison et al., Tuschl and Yu et al. In this context, the Examiner asserted that the evidence submitted with the Rule 131 Declaration did not show the concept of the loop sequence. The claims have been amended so that they no longer include the loop sequence concept. Since this concept has been deleted from the claimed subject matter, Applicants submit that the previously submitted Rule 131 Declaration is sufficient to evidence a prior invention with respect to the presently claimed subject matter.

In view of the earlier date of invention with respect to the amended claims as established by the previously submitted Rule 131 Declaration and the consequent removal of Paddison et al.,

Tuschl and Yu et al. as prior art, Applicants submit that the presently claimed invention is not rendered obvious by the prior art.

In view of the above amendments, remarks and the previously submitted Rule 131 Declaration, it is submitted that the present invention is not rendered obvious by the prior art. Withdrawal of this rejection is requested.

**Rejection under 35 U.S.C. § 103(a)**

The Examiner rejected claims 6-7 under 35 U.S.C. §103(a) as being unpatentable over Tuschl (May 2002) and Livache (1998) in view of Jeng (1990). Applicants submit that the Examiner is in error in this rejection.

As previously noted by Applicants, this rejection is technically improper because claims 6 and 7 are dependent on claim 1, and claim 1 was not rejected over Tuschl, Livache et al. and Jeng et al. Since Tuschl, Livache et al. and Jeng et al. apparently do not disclose or suggest all of the limitations of claim 1 (since claim 1 was not rejected over these three references alone), then the combination of Tuschl and Livache et al. with Jeng et al. also does not disclose or suggest all of the limitations of claims 6 and 7, which necessarily include all the limitations of claim 1.

Furthermore, the presently claimed invention has a date prior to Tuschl as detailed above (Applicants note that the evidence submitted in support of the Rule 131 Declaration shows 6 adenosines.). In view of the earlier date of invention with respect to the amended claims as established by the previously submitted Rule 131 Declaration and the consequent removal of Tuschl as prior art, Applicants submit that the presently claimed invention is not rendered obvious by the prior art.

In view of the above amendments, remarks and the previously submitted Rule 131 Declaration, it is submitted that the present invention is not rendered obvious by the prior art. Withdrawal of this rejection is requested.

### **Rejection under 35 U.S.C. § 103(a)**

The Examiner rejected claims 22-23 under 35 U.S.C. §103(a) as being unpatentable over Paul (published in May 2002) in view of Livache et al. (US 5,795,715). Applicants submit that the Examiner is in error in this rejection.

Applicants submit that this rejection is technically improper because claims 22 and 23 are dependent on claim 17 which is dependent on claim 1. Neither claim 1 nor claim 17 were rejected over Paul et al. and Livache et al. Since Paul et al. and Livache et al. apparently do not disclose or suggest all of the limitations of claims 1 and 17 (since claims 1 and 17 were not rejected over these three references alone), then the combination of Paul et al. and Livache et al. also does not disclose or suggest all of the limitations of claims 22 and 23, which necessarily include all the limitations of claims 1 and 17.

As noted in response to the previous Office Action, Applicants determined that the present invention was made prior to 15 April 2002 and thus prior to Paul et al. As noted above, the presently claimed subject matter does not contain a loop sequence. Applicants note that the evidence submitted in support of the Rule 131 Declaration shows transfection with multiple cassettes, i.e. a double stranded DNA co-transfected with sister construct. In view of the earlier date of invention of the presently claimed invention and the consequent removal of Paul et al. as prior art, Applicants submit that the claimed invention is not rendered obvious by the prior art.

In view of the above amendments, remarks and the previously submitted Rule 131 Declaration, it is submitted that the present invention is not rendered obvious by the prior art. Withdrawal of this rejection is requested.

### **Conclusion**

In view of the above amendments and remarks, it is believed that the claims satisfy the requirements of the patent statutes and reconsideration of the instant application and early notice

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of allowance are requested. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

Respectfully submitted,

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